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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,045	09/13/2003	David J. Laverick	702.276	1970

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EXAMINER

LUU, MATTHEW

ART UNIT	PAPER NUMBER
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3663

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/663,045

Applicant(s)

LAVERICK ET AL.

Examiner

LUU MATTHEW

Art Unit

3663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 23-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/1/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The new added limitation in claim 1, lines 7-9, "and is functional as a navigation device both when received within the mounting assembly and when being used independently of the mounting assembly" contains new matter, which was not described in the specification as originally filed.

Dependent claims 2-7 and 23 are also considered rejected for incorporating the defects from their respective parent claim 1 by dependency.

Regarding claim 23, "wherein the support pillar runs along and directly above the vehicle's windshield" contains new matter, which as not described in the specification as originally filed.

Art Unit: 3663

Claims 27-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The new added limitation in claim 27, lines 7-11, "a retractable face plate mounted within the docking station and operable to retract when the navigation device is received within the docking station and extend when the navigation device is removed from the docking station, thereby covering the void left in the docking station" was not described in the specification as originally filed.

Claims 27 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Independent claim 24 is drawn to "a mounting assembly for mounting on an existing support pillar of the vehicle" as shown in Fig. 14 of the drawings. However, dependent claim 27 is drawn to "a retractable face plate mounted within the docking station and operable to retract when the navigation device is received within the docking station and extend when the navigation device is removed from the docking station, thereby covering the void left in the docking station", which is not related to Fig. 14 of

Art Unit: 3663

the drawings. Therefore, it is not clear where exactly in the specification and drawings that connect the retractable face plate as claimed (claim 27) to the mounting assembly on an existing support pillar of the vehicle (claim 24). Therefore, claim 27 may be a different species of embodiment, which is different than the species of embodiment of Fig. 14.

Dependent claim 28 is considered rejected for incorporating the defect from its respective parent claim 27 by dependency.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kempers et al (5,415,554) in view of Schoenfish (6,370,037) and Funk et al (6,681,176).

Regarding claim 1, Kempers discloses (Figs. 1, 2 and 4) a navigation assembly (a compass 50 and a compass housing 28); and a mounting assembly (Fig. 4, panel 21) for mounting on a support pillar (18) of the vehicle (10) and sized and configured to receive the navigation device (compass 50) (Column 3, lines 21-42; and column 4, lines

Art Unit: 3663

20-24). Kempkers further discloses (Fig. 1) wherein the navigation device (50) remains visible (visible display 54) when received within the mounting assembly (panel 21).

The only different between the disclosure of Kempkers and the claimed invention is that claim 1 requires "a portable" navigational device, which is functional as a navigation device both when received within the mounting assembly and when being used independently of the mounting assembly.

However, both of Schoenfish (6,370,037) (Figs. 1 and 5) and Funk (6,681,176) (Figs. 4 and 6) disclose a portable navigational device, which is functional as a navigation device both when received within the mounting assembly and when being used independently of the mounting assembly. See Schoenfish (column 1 lines 10-13; and column 5, lines 19-24); and Funk (column 3, lines 44-57; and column 6, line 44 to column 7, line 8).

Therefore, it would have been obvious to a person of ordinary skill in the art to use the Schoenfish ('037) and Funk ('176) for the navigation device of Kempkers to provide a navigation GPS device, which can be used as an in-car navigation device and a handheld navigation unit for hiking or pedestrian navigation, as suggested by Funk (Column 3, lines 44-57). Furthermore, this is well known in the art.

Regarding claim 2, Funk ('176) discloses (Figs. 4 and 6) the handheld navigation unit (42) can be used as an in-car navigation device and a handheld navigation unit for hiking or pedestrian navigation (Column 3, lines 44-57).

Regarding claim 3, Kempkers discloses (Fig. 1) wherein the support pillar (18) is a pillar. Furthermore, whether the navigation device is installed on the side pillar or the pillar above the windshield is an obvious design choice since it is not critical to the function of the navigation device.

Regarding claim 4, Schoenfish discloses (Figs. 1 and 4) a mounting assembly (10) includes a trim piece (bracket 72), a base (68) secured to the trim (72), a docking station (cradle 16) mounted within the base (68), and a retractable face plate GPS 12) mounted within the docking station (16) (Column 3, lines 7-44).

Therefore, it would have been obvious to the person of ordinary skill in the art to use the mounting assembly of Shoenfish for the support pillar mounting assembly of Kempkers to provide a secure mounting assembly that allows the navigation device can easily detachable as a handheld navigation unit for hiking or pedestrian navigation, as suggested by Funk (Column 3, lines 44-57).

Regarding claim 5, Kempkers discloses (Figs. 3-5) electrical connections.

Art Unit: 3663

Regarding claim 6, Funk discloses (Figs. 1 and 2) a docking station which includes CD player which is well known to have a speaker. Furthermore, it is well known in the art that navigation device is voice activated.

Regarding claim 23, Kempkers discloses (Fig. 1) wherein the support pillar (18) is a pillar. Furthermore, whether the navigation device is installed on the side pillar or the pillar above the windshield is an obvious design choice since it is not critical to the function of the navigation device.

Regarding claims 24-26, note the rejections as set forth above with respect to claims 1-3.

Regarding claim 27, Schoenfish discloses (Figs. 1 and 4) a mounting assembly (10) includes a trim piece (bracket 72), a base (68) secured to the trim (72), a docking station (cradle 16) mounted within the base (68), and a retractable face plate GPS 12) mounted within the docking station (16) (Column 3, lines 7-44).

Therefore, it would have been obvious to the person of ordinary skill in the art to use the mounting assembly of Shoenfish for the support pillar mounting assembly of Kempkers to provide a secure mounting assembly that allows the navigation device can easily detachable as a handheld navigation unit for hiking or pedestrian navigation, as suggested by Funk (Column 3, lines 44-57). Furthermore, it is well known in the art that the car cassette player or a CD music disc player having a face plate for inserting music

Art Unit: 3663

tape or music CD within the docking station and "operable" to retract when the music tape is received within the docking station and extend when the music tape is removed from the docking station, thereby covering the void left by the docking station.

Regarding claim 28, note the rejection as set forth above with respect to claim 6.

Regarding claim 29, note the rejection as set forth above with respect to claim 5.

Claim Rejections - 35 USC § 103

Claims 7 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kempkers in view of Schoenfish ('037) and Funk ('176) as applied to claims 1-6 above, and further in view of Ockerse et al (6,928,366).

Regarding claims 7 and 30, Kempkers fails to disclose the GPS device.

However, Ockerse discloses (Fig. 3) a GPS device includes a navigation component (GPS 118 and magnetic sensor circuit 102), a processor (110), a memory (non-volatile memory 112), a display (heading indicator 114), an input (user input 116), and it is well known in the art that these well known components are assembled in the housing. See column 9, line 40 to column 10, line 30.

Therefore, it would have been obvious to the person of ordinary skill in the art to use the GPS compass device of Ockerse for the compass device of Kempkers to provide a more accurate navigation device.

Response to Arguments

Applicant's arguments with respect to claims 1-7 and 23-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUU MATTHEW whose telephone number is (571) 272-7663. The examiner can normally be reached on Flexible Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JACK KEITH can be reached on (571) 272-7663. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M. Luu



**MATTHEW LUU
PRIMARY EXAMINER**